

DT



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,875	04/18/2000	John S. Hendricks	5317	6429

7590 12/17/2004

John K Harrop
Dorsey & Whitney LLP
Suite 400 South
1001 Pennsylvania Avenue, N.W.
Washington, DC 20004

EXAMINER

KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
----------	--------------

2611

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,875

Applicant(s)

HENDRICKS ET AL.

Examiner

Andrew Y Koenig

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 21-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/18/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1 is objected to because of the following informalities:

Regarding claim 1, line 12, there is no antecedence for "the authorization request." Accordingly, "the authorization request" will be interpreted as "an authorization request."

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 13, line 1, the claim recites "the time after start of the program," however there is no antecedence for this limitation. It appears that claim 13 should depend from claim 12 and for the rest of this office action; claim 13 will be interpreted as depending from claim 12.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2611

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent 5,357,276 to Banker et al. (Banker '276).

Regarding claim 1, Banker '276 teaches generating program data related to the broadcast programming (fig. 6A, 6B, 7A, 7B) inserted at the data controller (fig. 1, label 20, col. 4, ll. 9-18), which is transmitted to the end users as shown in figure 1 and displayed at the user location (fig. 6A, 6B, 7A, 7B). Further, Banker '276 teaches the billing computer (fig. 1, label 11) which sends an authorization transaction to the subscribers (col. 3, ll. 34-45), which is initiated by the user requesting a program order designating at least one program to be viewed (col. 10-11, ll. 66-22); the broadcaster transmits the program and program authorization multiplexed together (fig. 1, col. 3 ll. 46-64). Banker '276 is silent on digital programming; Official Notice is taken that digital programming is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by using digital programming in order to increase bandwidth of a given physical channel thereby enabling a higher data throughput.

6. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent 5,357,276 to Banker et al. (Banker '276) in view of U.S. Patent 5,539,450 to Handelman.

Regarding claim 2, Banker '276 teaches billing the user (col. 4, ll. 40-57), but is silent on debiting the subscriber's account. Handelman teaches a smart card containing

Art Unit: 2611

the subscriber accounting data (col. 14, ll. 44-47), wherein Handelsman teaches debiting the user account (col. 22-23, ll. 54-11, see also fig. 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by debiting the subscriber account as taught by Handelsman in order to pay for services over the cable network thereby providing a simple interface to pay off debts.

Regarding claim 3, Banker '276 teaches billing the user (col. 4, ll. 40-57), but is silent on sending the billing record to a subscriber for payment. Handelsman teaches a smart card containing the subscriber accounting data (col. 14, ll. 44-47), wherein Handelsman teaches debiting the user account (col. 22-23, ll. 54-11, see also fig. 25), which equates to sending the billing record to a subscriber for payment. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by sending the billing record to a subscriber for payment as taught by Handelsman in order to pay for services over the cable network thereby providing a simple interface to pay off debts.

Regarding claim 4, Banker '276 teaches billing the user (col. 4, ll. 40-57), but is silent on charging a credit card. Handelsman teaches charging a credit card (col. 10, ll. 5-10, col. 22, ll. 47-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by charging a credit card as taught by Handelsman in order to pay for services over the cable network thereby providing a simple interface to pay off debts.

Regarding claim 5, Banker '276 teaches billing the user (col. 4, ll. 40-57), but is silent on debiting a cash card included in a terminal, and sending a debit signal

Art Unit: 2611

corresponding to the record to the terminal. Handelman teaches a smart card containing the subscriber accounting data (col. 14, ll. 44-47), wherein Handelman teaches debiting the user account (col. 22-23, ll. 54-11, see also fig. 25) by a signal transmitted to the receiver (col. 21-22, ll. 66-13), which equates to debiting a cash card included in a terminal, and sending a debit signal corresponding to the record to the terminal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by debiting a cash card included in a terminal, and sending a debit signal corresponding to the record to the terminal as taught by Handelman in order to pay for services over the cable network thereby providing a simple interface to pay off debts.

Regarding claim 6, Banker '276 teaches billing the user (col. 4, ll. 40-57), but is silent on a cash card part of a smart card. Handelman teaches a cash card part of a smart card (col. 14, ll. 44-47, col. 22-23, ll. 54-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by using a cash card part of a smart card as taught by Handelman in order to pay for services over the cable network thereby providing a simple interface to pay off debts.

Regarding claim 7, Banker '276 is silent on sending a credit signal to a terminal upon receipt of payment from the subscriber. Official Notice is taken that receiving a receipt of signal is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by

transmitting a receipt in order to provide evidence that a purchase has been made thereby enabling the user to have verification of the product/service that was purchased.

7. Claims 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,357,276 to Banker et al. (Banker '276) in view of U.S. Patent 5,412,720 to Hoarty et al. (Hoarty).

Regarding claim 8, Banker '276 teaches generating program data related to the broadcast programming (fig. 6A, 6B, 7A, 7B) inserted at the data controller (fig. 1, label 20, col. 4, ll. 9-18), which is transmitted to the end users as shown in figure 1 and displayed at the user location (fig. 6A, 6B, 7A, 7B). Further, Banker '276 teaches the billing computer (fig. 1, label 11) which sends an authorization transaction to the subscribers (col. 3, ll. 34-45), which is initiated by the user requesting a program order designating at least one program to be viewed (col. 10-11, ll. 66-22); the broadcaster transmits the program and program authorization multiplexed together (fig. 1, col. 3 ll. 46-64). Banker '276 is silent on digital programming; Official Notice is taken that digital programming is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by using digital programming in order to increase bandwidth of a given physical channel thereby enabling a higher data throughput. Banker '276 is silent on decrypting the program. Hoarty teaches decrypting programming after being received by the receiver (col. 11, ll. 28-31). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by decrypting the

encrypted programming as taught by Hoarty in order to protect programming from being viewed by unauthorized persons.

Regarding claim 14, Banker '276 teaches the broadcaster is co-located with the order and authorization system (fig. 1, col. 3-4, ll. 65-8, col. 10-11, ll. 66-22).

8. Claims 9, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,357,276 to Banker et al. (Banker '276) and U.S. Patent 5,412,720 to Hoarty et al. (Hoarty) in view of U.S. Patent 5,539,450 to Handelman.

Regarding claim 9, Banker '276 teaches billing the user (col. 4, ll. 40-57), but Banker '276 and Hoarty are silent on debiting a cash card included in a terminal, and sending a debit signal corresponding to the record to the terminal. Handelman teaches a smart card containing the subscriber accounting data (col. 14, ll. 44-47), wherein Handelman teaches debiting the user account (col. 22-23, ll. 54-11, see also fig. 25) by a signal transmitted to the receiver (col. 21-22, ll. 66-13), which equates to debiting a cash card included in a terminal, and sending a debit signal corresponding to the record to the terminal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 and Hoarty by debiting a cash card included in a terminal, and sending a debit signal corresponding to the record to the terminal as taught by Handelman in order to pay for services over the cable network thereby providing a simple interface to pay off debts.

Regarding claim 10, Banker '276 teaches billing the user (col. 4, ll. 40-57), but Banker '276 and Hoarty are silent on a cash card part of a smart card. Handelman

teaches a cash card part of a smart card (col. 14, ll. 44-47, col. 22-23, ll. 54-11).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 and Hoarty by using a cash card part of a smart card I as taught by Handelman in order to pay for services over the cable network thereby providing a simple interface to pay off debts.

Regarding claim 15, Banker '276 and Hoarty are silent on sending a credit signal to a terminal upon receipt of payment from the subscriber. Official Notice is taken that receiving a receipt of signal is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 and Hoarty by transmitting a receipt in order to provide evidence that a purchase has been made thereby enabling the user to have verification of the product/service that was purchased.

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,357,276 to Banker et al. (Banker '276) and U.S. Patent 5,412,720 to Hoarty et al. (Hoarty) in view of U.S. Patent 4,686,564 to Masuko et al. (Masuko).

Regarding claim 12, Banker '276 teaches canceling a program prior to the showing of the program (col. 10, ll. 25-33), which equates to a time out feature is effective for a time prior to the start of the program. Banker '276 is silent on a time out feature that allows cancellation of the program order without incurring charge, wherein the time-out feature is effective for a time after the start of the program. Masuko teaches canceling a program without incurring a charge, wherein the time out feature is

Art Unit: 2611

effective for a time after the start (col. 18, ll. 23-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by permitting the user to cancel after the start of the programming as taught by Masuko in order to provide for a more friendly user interface and system.

Regarding claim 13, Banker '276 and Masuko are silent on the time after the start of the program being 5 minutes. Official Notice is taken that different times are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 and Masuko by permitting the user to cancel 5 minutes after the start of the programming in order to provide a uniform standard of time for the user to cancel out, thereby enabling the user to opt of programming within a known period of time.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,357,276 to Banker et al. (Banker '276), U.S. Patent 5,412,720 to Hoarty et al. (Hoarty), and U.S. Patent 4,686,564 to Masuko et al. (Masuko) in view of U.S. Patent 5,539,450 to Handelman.

Regarding claim 11, Banker '276 is silent on the cash card being removable or fixed to the smart card. Handelman teaches a cash card part of a smart card (col. 14, ll. 44-47, col. 22-23, ll. 54-11), which equates to a cash card being fixed to the smart card. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by using a cash card part of a smart card I

Art Unit: 2611

as taught by Handelman in order to pay for services over the cable network thereby providing a simple interface to pay off debts.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,357,276 to Banker et al. (Banker '276) in view of U.S. Patent 5,317,391 to Banker et al. (Banker '391).

Regarding claim 16, Banker '276 teaches generating program data related to the broadcast programming (fig. 6A, 6B, 7A, 7B) inserted at the data controller (fig. 1, label 20, col. 4, ll. 9-18), which is transmitted to the end users as shown in figure 1 and displayed at the user location (fig. 6A, 6B, 7A, 7B). Further, Banker '276 teaches the billing computer (fig. 1, label 11) which sends an authorization transaction to the subscribers (col. 3, ll. 34-45), which is initiated by the user requesting a program order designating at least one program to be viewed (col. 10-11, ll. 66-22); the broadcaster transmits the program and program authorization multiplexed together (fig. 1, col. 3 ll. 46-64). Banker '276 is silent on digital programming; Official Notice is taken that digital programming is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by using digital programming in order to increase bandwidth of a given physical channel thereby enabling a higher data throughput. Banker '276 is silent on a time out period to cancel an order. Banker '391 teaches a time out (fig. 9D). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

modify Banker '276 by using time outs as taught by Banker '391 in order to deauthorize the display and prevent charges.

12. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,357,276 to Banker et al. (Banker '276) and U.S. Patent 5,317,391 to Banker et al. (Banker '391) in view of U.S. Patent 4,686,564 to Masuko et al. (Masuko).

Regarding claim 17, Banker '276 is silent on waiting for a time out period to determine if a cancel order has been received, if it is received in the time out period, then generating and transmitting a deauthorization signal, wherein the deauthorization signal removes access to a previously authorized signal. Masuko teaches canceling a program without incurring a charge, wherein the time out feature is effective for a time after the start (col. 18, ll. 23-55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 by permitting the user to cancel after the start of the programming as taught by Masuko in order to provide for a more friendly user interface and system. Banker '276 and Masuko are silent on transmitting a deauthorization signal, wherein the deauthorization signal removes a previously authorized signal. Official Notice is taken that transmitting a deauthorization signal, wherein the deauthorization signal removes a previously authorized signal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 and Masuko by transmitting a deauthorization signal, wherein the deauthorization signal removes a

previously authorized signal in order to prevent unauthorized viewing of programming by the user.

13. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,357,276 to Banker et al. (Banker '276) and U.S. Patent 5,317,391 to Banker et al. (Banker '391) in view of U.S. Patent 5,539,450 to Handelsman.

Regarding claim 18, Banker '276 teaches billing the user (col. 4, ll. 40-57), but Banker '276 and Banker '391 are silent on debiting a cash card included in a terminal, and sending a debit signal corresponding to the record to the terminal. Handelsman teaches a smart card containing the subscriber accounting data (col. 14, ll. 44-47), wherein Handelsman teaches debiting the user account (col. 22-23, ll. 54-11, see also fig. 25) by a signal transmitted to the receiver (col. 21-22, ll. 66-13), which equates to debiting a cash card included in a terminal, and sending a debit signal corresponding to the record to the terminal. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 and Banker '391 by debiting a cash card included in a terminal, and sending a debit signal corresponding to the record to the terminal as taught by Handelsman in order to pay for services over the cable network thereby providing a simple interface to pay off debts.

Regarding claim 19, Banker '276 teaches billing the user (col. 4, ll. 40-57), but Banker '276 and Banker '391 are silent on a cash card part of a smart card. Handelsman teaches a cash card part of a smart card (col. 14, ll. 44-47, col. 22-23, ll. 54-11). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify Banker '276 and Banker '391 by using a cash card part of a smart card I as taught by Handelman in order to pay for services over the cable network thereby providing a simple interface to pay off debts.

Regarding claim 20, Banker '276 and Banker '391 are silent on sending a credit signal to a terminal upon receipt of payment from the subscriber. Official Notice is taken that receiving a receipt of signal is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Banker '276 and Banker '391 by transmitting a receipt in order to provide evidence that a purchase has been made thereby enabling the user to have verification of the product/service that was purchased.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y Koenig whose telephone number is (703) 306-0399. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (703) 305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ayk



CHRIS GRANT
PRIMARY EXAMINER